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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,648	05/10/2001	Dennis Andrew Benjamin	10329-3	8782

7590 12/17/2003

Brinks Hofer Gilson & Lione
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Chicago, IL 60610

EXAMINER

MEKY, MOUSTAFA M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/486,648

Applicant(s)

BENJAMIN ET AL.

Examiner

Moustafa M Meky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The amendment filed on 9/8/2003 has been entered and considered by the examiner.
2. Claims 30-117 are presenting for examination.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 30, 33-39, 47, 50-56, 64, 67-73, 81, 85-91, 99-102, 110, 112-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo (US 6,374,246).
5. As to claim 30, Matsuo shows in Fig 1, a method for conveying an email message including an address field containing a descriptor (such as a phone number and facsimile number) of an intended recipient of the message, the descriptor (phone number and/or facsimile number) being different from an email account name (recipient's name) of the intended recipient, the method of Matsuo comprising:

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* sending a database query to a database 12 containing a plurality of identifying elements (phone numbers, facsimile numbers, terminal data) associated with the intended recipient and email addresses to search for the email address associated with the descriptor, see Fig 2, col 3, lines 39-50, col 4, lines 31-56, col 5, lines 16-26, lines 37-42 ; and

* transmitting the message to the email address found if a unique email address is located, see col 2, lines 17-19, col 5, lines 33-36.

6. As to claim 33, Matsuo shows that the descriptor such as TEL03-111-2222 includes a concatenation of a name (TEL) and telephone number (111-2222), see col 4, line 54.

7. As to claims 34-38, Matsuo shows generating and conveying a return email notification to the sender to report the status of the database search, etc, see col 5, lines 42-47.

8. As to claim 39, Matsuo shows formatted email messages are interpreted as database queries, see col 5, lines 27-36.

9. As to claim 116, Matsuo shows transmitting the message where a prescribed threshold (single match) of a match between the descriptor (such phone number and/or facsimile number) of the message and descriptors (phone numbers, terminals Ids, and facsimile numbers) of the database is exceeded (more than one entry in the database for the same user), see Fig 2, col 3, lines 39-50, col 4, lines 31-56, col 5, lines 16-26, lines 37-42.

10. As to claims 47, 50-56, 64, 67-73, 81, 85-91, 99-102, 117, the claims are similar in scope to claims 30, 33-39, 116, and they are rejected under the same rationale.

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11. As to claim 110, 112-115, the claims are similar in scope to claim 30. In addition, Matsuo shows the different telecommunications devices such as a telephone, facsimile, etc, see col 6, lines 20-22, lines 44-46, col 7, lines 1-9.

Therefore, it can be seen from paragraphs 5-11 that Matsuo anticipates claims 30, 33-39, 47, 50-56, 64, 67-73, 81, 85-91, 99-102, 110, 112-117.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 31-32, 40, 48-49, 57, 65-66, 74, 82-84, 92, 103, 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo.

14. As to claims 31-32, 40, Matsuo shows in Fig 1, a method for conveying an email message as been discussed in paragraph 5 above. Matsuo does not teach all available information such as business name and a street name (notice that Matsuo uses phone and facsimile numbers).

Obviously, there is no restrictions to put any available information for the intended recipients in the database. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Matsuo to include all available information for the recipient in the database in order to increase the system flexibility to specify the recipient

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email address (the sender would have the flexibility to use any information he is aware of about the recipient such as street name, business name in the address filed of the email message).

15. As to claims 48-49, 57, 65-66, 74, 82-84, 92, 103, 111, the claims are similar in scope to claims 31-32, 40, and they are rejected under the same rationale.

Therefore, it can be seen from paragraphs 14-15 that the modified system of Matsuo teaches the limitations of claims 31-32, 40, 48-49, 57, 65-66, 74, 82-84, 92, 103, 111.

16. Claims 41-46, 58-63, 75-80, 93-98, 104-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo in view of Agraharam (US Pat. No. 5,987,508).

17. As to claims 41-46, Matsuo shows in Fig 1, a method for conveying an email message as been discussed in paragraph 5 above. Matsuo is silent about the registration process assuming that all the users in the system are already registered members. However, Agraharam shows the registration process, see col 3, lines 35-50, col 4, lines 13-41, col 5, lines 38-58. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Agraharam with the system of Matsuo in order to enable a user to send and receive messages using the system.

18. As to claims 58-63, 75-80, 93-98, 104-109, the claims are similar in scope to claims 41-46, and they are rejected under the same rationale.

Therefore, it can be seen from paragraphs 17-18 that the combination of Matsuo and Agraharam teaches the limitations of claims 41-46, 58-63, 75-80, 93-98, 104-109.

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19. The rejection of claims 110-115 under 35 USC 112,1st paragraph has been withdrawn.

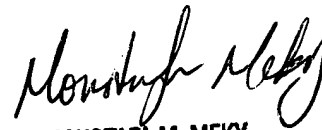
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Moustafa M. Meky whose telephone number is (703) 305-9697. The examiner can normally be reached on week days from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The fax number for official correspondence/amendment is (703) 872-9306.

M.M.M

November 11, 2003


MOUSTAF A M. MEKY
PRIMARY EXAMINER